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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/626,903

07/25/2003

Clarence E. Cowan

TAL:1016.098

2423

7590

11/29/2004

Chernoff Vilhauer McClung & Stenzel, L.L.P.
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EXAMINER

CHAN, EMILY Y

ART UNIT

PAPER NUMBER

2829

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,903

Applicant(s)

COWAN ET AL.

Examiner

Emily Y Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 11-13 and 16-18 is/are rejected.
- 7) ☐ Claim(s) 4, 5, 9, 10, 14, 15, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In view of the remarks (i.e. evidence of the common ownership) filed on 9/23/04, the rejection based on Paters et al ('236) in view of Kholodendo et al ('755) (Note: The missing Kholodendo et al ('755) in the rejection statement on page 3 of the prior office action was a clear typing error in view of the rejection body) is withdrawn. A new rejection is applied as follows:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 6, 11 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 11 of U.S. Patent No. 6,445,202. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims 1 -2 and 11 of U. S. Patent No. 6,445,202 and the claims 1, 6, 11 and 16 of the instant invention are directed to the same enclosure and thermal device for a probe station chuck. The claimed components, associated with the functions recited in claims 1, 6, 11 and 16 of the instant invention

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such as "probe station", "chuck" "supporting surface", a "thermal device", "enclosure", "outer surface" (see claim 2, "conductive shell substantially enclosing said thermal unit" of Patent No. 6,445,202), "inner surface" (see claim 2, "a surface interposed between said thermal unit and said first surface" of U. S. Patent No. 6,445,202) and "controller" are all recited in the claims 1-2 and 11 of Patent No. 6,445,202. Therefore, the claims 1-2 and 11 of U. S. Patent No. 6,445,202 encompass the scope of the claims 1, 6, 11 and 16 of the instant invention.

2. Claims 2-3, 7-8, 12-13 and 17-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 11 of U.S. Patent No. 6,445,202 in view of Hollman ('299).

Claims 1-2 and 11 of U.S. Patent No. 6,445,202 do not recite an electrically conductive connection of a conductive wall to an instrument and an electrically conductive connection of the instrument to a ground.

Hollman ('299) discloses a high resolution analytical probe station (see Figs 2 and 3a) and exclusively teaches an enclosure (26) comprising an electrically conductive connection of a conductive wall (27) to an instrument (see Col. 3, lines 57-61 and Col. 7, lines 14-15) and an electrically conductive connection of the instrument to a ground (see Col. 7, line 29 "ground").

It would have been obvious to one of skilled in the art at the time the claimed invention was made to incorporate the teaching of Hollman ('299)'s electrically conductive connection of the conductive wall to the instrument and the connection of the instrument to the ground into the enclosure of claims 1-2 and 11 of U.S. Patent No.

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6,445,202 for the expected benefit of providing a vacuum chamber or an enclosure for high resolution analytical probe station as disclosed by Hollman ('299) (see Col. 1, lines 43-46).

Allowable Subject Matter

3. Claims 4-5, 9-10, 14-15 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

4. Claims 4-5, 9-10, 14-15 19-20 are indicated allowable because the prior art does not teach or suggest an enclosure for a probe station chuck with detail of all the elements in combination recited in claims 4, 9, 14 and 19. Specifically, the prior art does not teach the switch having a first terminal selectively connectable to a second terminal, the second terminal being conductively connected to the conductive wall and the first terminal being conductively connected to a ground. Claims 5, 10, 15 and 20 dependent on claims 4, 9, 14 and 19 respectively and are allowed accordingly.

Response to Amendment

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Y Chan whose telephone number is 571-272-1956. The examiner can normally be reached on 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Tokar can be reached on 571-272-1812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ec
11-16-04


DAVID ZARNEKE
PRIMARY EXAMINER
11/22/04